

Application No. 10/014,452

REMARKS

Claim 1 has been amended by incorporating the recitations of former claims 7 and 12 therein. Claims 7 and 12 have thereby been cancelled. Applicants respectfully request entry of the above amendments at this late stage in prosecution. Applicants did not make these amendments earlier, as Applicants did not believe such amendments would be necessary to obtain allowance of the present application.

Review and reconsideration on the merits are further requested.

Claims 1, 4, 6-11, 18, 21, and 22-25 have been rejected under 35 USC §103 as obvious over Parker, et al. in view of Arnold, et al. In response, Applicants traverse the rejection.

As discussed previously, Parker, et al. teaches a puzzle cut seamed belt having a polyimide substrate and a polyamide adhesive. The reference does not teach or suggest the adhesive comprising an oxalic acid or a plasticizer as claimed. In addition, the reference does not teach or suggest the adhesive comprising electrically conductive filler as claimed.

Arnold, et al. teaches a polyamide adhesive comprising bisphenol as an adhesive promoter. The reference teaches use of from 1 to 25, 2 to 10, and up to 5 percent of the bisphenol by weight of the polyamide. Arnold, et al. also teaches use of the oxalic acid. However, Arnold, et al., does not teach or suggest use of an electrically conductive filler in the polyamide adhesive as claimed.

Therefore, neither reference teaches or suggests the use of an electrically conductive filler in the claimed polyamide adhesive.

Not only do the references not teach or suggest all of the elements of the present claims, in addition, Applicants submit that one of ordinary skill in the art would not have been motivated to combine the references cited. To begin with, Parker, et al. teaches use of a polyamide adhesive in combination with a polyimide belt. On the other hand, Arnold, et al. teaches use of a polyamide adhesive in combination with a polyester material (col. 1, lines 43-46; and Example 2, col. 5, lines 17-20). Therefore, Applicants submit that one of ordinary skill in the art would not have been motivated to

Application No. 10/014,452

use a polyamide adhesive containing an oxalic acid and bisphenol plasticizer as taught by Arnold, et al. in combination with a polyester, as plasticizers in a polyamide adhesive in combination with a polyimide belt as taught by Parker, et al. Applicants respectfully point out that specific adhesives work well with only specific types of materials. Applicants submit that there would not have been any expectation of success that a polyamide adhesive taught in combination with a polyester material, would work well as an adhesive for a polyimide belt as claimed and as taught by Parker, et al.

Further, Applicants repeat that the combination does not teach all the elements of the claims, namely, an electrically conductive filler in polyamide adhesive.

In view of the above, Applicants submit that the claims are not obvious in view of the cited combination. Accordingly, Applicants request withdrawal of the rejection of claims 1, 4, 6-11, 18, 21, and 22-25 under 35 USC §103 as obvious over Parker, et al. in view of Arnold, et al.

Claims 12 and 14-16 have been rejected under 35 USC §103 as obvious over Parker, et al. in view of Arnold, et al., and further in view of Schlueter, Jr., et al. In response, Applicants traverse the rejection.

Schlueter, Jr., et al. does teach the use of electrically conductive fillers in combination with an adhesive. However, Applicants submit that one of ordinary skill in the art would not have been motivated to modify the adhesive of Parker, et al., and Arnold, et al., to include electrically conductive fillers absent some teaching or suggestion. Schlueter, Jr., et al. teaches an adhesive comprising polyvinyl butyral composition comprising a terpolymer of polyvinyl butyral, polyvinyl alcohol, and polyvinyl acetate, and a plasticizer; or a polyurethane composition including a polyester polyurethane polymer, or a blended composition including an acrylonitrile butadiene copolymer and a phenyl formaldehyde polymer. The reference does not teach or suggest a polyamide adhesive as claimed and as taught by both Parker, et al. and Arnold, et al.

In addition, Applicants point out that Schlueter, Jr., et al. teaches a completely different plasticizer than that as claimed and as taught by Arnold, et al. Instead, the reference at col. 10, lines 28-29, teaches a plasticizer of dialkyl phthalate. Therefore, Applicants submit that one of ordinary skill in the art faced with the teachings of a

Application No. 10/014,452

plasticizer comprising dialkyl phthalate, would not have been motivated to alter the plasticizer into the plasticizer of Arnold, et al., absent some teaching or suggestion.

Applicants submit that there would have been no expectation of success that an electrically conductive filler taught in combination with an adhesive of polyvinyl butyral, polyurethane, or a blended composition as taught by Schlueter, Jr., et al. in combination with a dialkyl phthalate plasticizer, would work with an adhesive comprising oxalic acid, bisphenol, and polyamide as taught by Arnold, et al.

Therefore, because the adhesive taught by Schlueter, Jr., et al. is completely distinguishable from the adhesive compositions taught by Parker, et al., which is further different from the adhesive taught by Arnold, et al., Applicants submit that one of ordinary skill in the art would not have been motivated to use the electrically conductive filler of Schlueter, Jr., et al. taught in combination with a dialkyl phthalate and polyvinyl butyral, polyurethane or acrylonitrile and butadiene copolymer, and use that with a polyamide, oxalic acid and bisphenol adhesive of Arnold, et al., absent some teaching or suggestion to make such a drastic change in the adhesive compositions taught by Parker, et al. and Arnold, et al.

In view of the above, Applicants submit that the claims are not obvious in view of the cited combination. Accordingly, Applicants request withdrawal of the rejection of claims 12 and 14-16 under 35 USC §103 as obvious over Parker, et al. in view of Arnold, et al., and further in view of Schlueter, Jr., et al.

Claim 13 has been rejected under 35 USC §103 as obvious over Parker, et al., Arnold, et al., and Schlueter, Jr., et al., in view of Yamasaki, et al. In response, Applicants traverse the rejection.

Applicants repeat the above arguments as to why one of ordinary skill in the art would not have been motivated to use the electrically conductive fillers taught by Schlueter, Jr., et al., in combination with the distinguishing adhesives of Parker, et al. and Arnold, et al. Applicants note that the Examiner states that Yamasaki, et al. teaches an electrically conductive filler as a quaternary ammonium salt for the purpose of creating an electrically conductive polyurethane foam. Applicants respectfully submit that absent some teaching or suggestion, one of ordinary skill in the art would not have been motivated to use the electrically conductive filler taught for use with a

Application No. 10/014,452

polyurethane foam on an electrically conductive roller, and use that electrically conductive filler with an adhesive material. Applicants further submit that it is an even greater stretch to argue that one of ordinary skill in the art would have been motivated to use an electrically conductive filler taught for use with a polyurethane foam, as a filler in a polyamide adhesive material. Not only does Yamasaki, et al. not teach an adhesive material, and use of an electrically conductive filler therein, but Yamasaki, et al., also does not teach or suggest a polyamide material in combination with an electrically conductive filler. Therefore, Applicants submit that absent some teaching or suggestion, one of ordinary skill in the art would not have been motivated to use the electrically conductive filler as taught by Yamasaki, et al., in combination with a polyurethane foam, as a filler in a polyamide adhesive. Applicants further point out that a polyurethane foam material is completely distinguishable from a polyamide adhesive.

In view of the above, Applicants submit that claim 13 is not rendered obvious in view cited combination. Accordingly, Applicants request withdrawal of the rejection of claim 13 under 35 USC §103 as obvious over Parker, et al., Arnold, et al., and Schlueter, Jr., et al., and further in view of Yamasaki, et al.

Claim 26 has been rejected under 35 USC §103 as obvious over Parker, et al., in view of Arnold, et al., and further in view of Schlueter, Jr., et al.

Applicants submit that the cancellation of claim 26 has rendered the rejection moot.

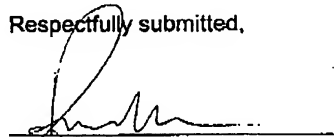
In view of the above arguments and amendments, Applicants submit that all claims should now be in condition for allowance. Early indication of allowability is respectfully requested.

No additional fee is believed to be required for this amendment. However, the undersigned Xerox Corporation attorney (or agent) hereby authorizes the charging of any necessary fees, other than the issue fee, to Xerox Corporation Deposit Account No. 24-0025. This also constitutes a request for any needed extension of time and authorization to charge all fees therefor to Xerox Corporation Deposit Account No. 24-0025.

Application No. 10/014,452

In the event the Examiner considers personal contact advantageous to the disposition of this case, s/he is hereby authorized to call Applicant's Attorney, Annette L. Bade, at telephone number (310) 333-3682.

Respectfully submitted,



Annette L. Bade
Attorney for Applicants
Registration No. 37,029
(310) 333-3682

ALB/cmu
December 2, 2004
Xerox Corporation
101 Continental Blvd. / ESC1-275
El Segundo, CA 90245